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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,517	07/08/2003	Motohiro Machida	240049US90X	7604
22850	7590	07/21/2006	EXAMINER	
C. IRVIN MCCLELLAND OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			LE, MICHAEL	
			ART UNIT	PAPER NUMBER
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DATE MAILED: 07/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/614,517	<b>Applicant(s)</b> MACHIIDA ET AL.	
	<b>Examiner</b> Michael Le	<b>Art Unit</b> 2163	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Summary and Status of Claims***

1. This Office Action is in response to Applicant's reply filed April 27, 2006.
2. Claims 1-12 are pending.
3. Claims 1-3 and 7-9 are rejected under 35 U.S.C. 112, first paragraph.
4. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph.
5. Claims 1-3 and 7-9 are rejected under 35 U.S.C. 101.
6. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogawa (US Patent Pub 2002/0087706) of record, in view of Skillen et al. (US Patent 6,098,065) of record, further in view of Suzuki et al. (US Patent 5,675,738) of record.
7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Specification***

8. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

9. The abstract of the disclosure is objected to because it exceeds the maximum length and it seems to have run-on sentences, which make the abstract difficult to follow. Correction is required. See MPEP § 608.01(b).

***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. **Claims 1-3 and 7-9 are rejected under 35 U.S.C. 112, first paragraph**, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

12. **Claims 1-3 and 7-9** recite a “Computer program product that stores instructions” in the preamble. Applicant cites paragraph 0074 as support for the amendment. Paragraph 0074 merely describes the configuration shown in figure 1. A computer program product is interpreted as a piece of software. Given this interpretation, the description in paragraph 0074 does not sufficiently support the amendment and thus fails to meet the written description requirement.

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13. **Claims 1-3 and 7-9 are rejected under 35 U.S.C. 112, second paragraph**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

14. **Claims 1 and 7** recite "A computer program product that stores instructions which when executed by a service provision computer system, causes the computer system to execute the steps..." in the preamble. The cited portion is unclear because as noted above, a computer program product is interpreted as a piece of software. It is unclear how a piece of software stores instructions to be executed by a computer system. Additionally, since a computer program product is interpreted as software, it is additionally rejected under 35 U.S.C. 101 as nonstatutory subject matter.

15. **Claims 2, 3, 8 and 9** are rejected because they depend on a rejected claim. Dependent claims contain the limitations of the parent claims and are therefore rejected for the same reasons.

16. The prior art rejections to claims 1-3 and 7-9 below are made as best understood in light of the rejection under 35 U.S.C. 112, second paragraph addressed above.

***Claim Rejections - 35 USC § 101***

17. **Claims 1-3 and 7-9 are rejected under 35 U.S.C. 101** because the claimed invention is directed to non-statutory subject matter.

18. The basis of this rejection is set forth in a test of whether the invention is categorized as a process, machine, manufacture or composition of matter and if the invention produces a useful, concrete and tangible result. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural

phenomena) are found to be non-statutory subject matter. For a method claim to pass muster, the recited process must produce a useful, concrete and tangible result.

19. In the present case, claims 1-3 and 7-9 recite a computer program product storing instructions to be executed by a computer system. A computer program product is interpreted as software per se and is not a tangible computer storage medium that stores instructions enabling a computer system to execute them. As such, the computer program product of claims 1-3 and 7-9 are nonstatutory.

20. To expedite a complete examination of the instant application, the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention

***Claim Rejections - 35 USC § 103***

**21. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogawa (US Patent Pub 2002/0087706) of record, in view of Skillen et al. (US Patent 6,098,065) of record, hereinafter "Skillen", further in view of Suzuki et al. (US Patent 5,675,738) of record, hereinafter "Suzuki".**

22. In regards to **claim 1**, Ogawa discloses a computer program product that stores instructions which when executed by a service provision computer system, causes the computer system to execute the steps comprising:

- a. storing and managing a plurality of tickets, (Ogawa: Fig. 2, element 317; para. 0125)<sup>1</sup> each ticket comprising a first identifier given to a commodity (Ogawa: Fig. 5,

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<sup>1</sup> Multiple rows in the table are interpreted as a plurality of tickets.

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element “mailname”), an access address of a service provider for providing a service related to the commodity (Ogawa: Fig. 5, element “URL”) and information about the commodity (Ogawa: Fig. 5, element “Comment”);

b. searching, based on the first identifier and a ticket request submitted by a user, a ticket of the plurality of tickets corresponding to the first identifier (Ogawa: para. 0143, 0144)<sup>2</sup>;

c. retrieving a corresponding access address of a corresponding service provider included in the ticket obtained by the search (Ogawa: para. 0143, 0144, 0145), requesting service provision content information from the service provider based on the access address of the service provider (Ogawa: para. 0148), and acquiring the service provision content information about the service (Ogawa: para. 0150);

d. presenting at least one of the information about the commodity included in the ticket and the service provision content information acquired (Ogawa: para. 0150);

23. Ogawa does not expressly disclose:

a. wherein the ticket further comprises information for deriving a second identifier different from the first identifier, as the information about the commodity or as the information about the service; and

b. wherein the searching comprises generating the second identifier based on information acquired from the ticket obtained by the search, and searching for a ticket corresponding to the second identifier.

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<sup>2</sup> The service provider apparatus receives the email from the user (ticket request) and extracts the relevant information and identifies the user's identification ID (first identifier) and then accordingly extracts comments corresponding to the requested goods and services.

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24. Skillen discloses as associative search engine, which receives a search request from a user that includes a search argument (identifier). The associate search engine then searches for all products (services) matching the search argument (identifier) as well as other related products that may be relevant to the user based on the search argument. The results are then displayed to the user. (Skillen: col. 4, lines 29-45). Skillen further discloses user profile data being stored in the user device and having it accessible by the associative search engine, thereby using the user profile data to augment the original search arguments to find the best fitting data for the user (Skillen: col. 5, lines 7-17, 61-63; col. 6, lines 4-12, 38-43). Skillen also discloses the search engine contains algorithms and techniques to derive search arguments during a single session with the product database (Skillen: col. 5, lines 29-34).

25. Ogawa and Skillen are analogous art because they are both from the same field of endeavor of information retrieval.

26. At the time of the invention it would have been obvious to a person of ordinary skill in the art to modify the system of Ogawa by adding to the ticket information for deriving a second identifier different from the first identifier, as the information about the commodity or as the information bout the service and modifying the searching to derive a second identifier based on information acquired from the ticket obtained by the search, and searching for a ticket corresponding to the second identifier, as taught by Skillen.

27. The motivation for doing so would have been because it is desirable for users to retrieve relevant information when searching for data, including associated information (Skillen: col. 1, lines 38-49).

28. Ogawa and Skillen do not expressly disclose:



- a. providing a procedure file that stores access method information for connection to a service;
- b. further including in the ticket, storage location information of the procedure file;
- c. retrieving from the ticket obtained by the search the corresponding storage location information of the procedure file and retrieving access method information from the procedure file based on the storage location information;
- d. acquiring the service provision content information about the service in accordance with an access method stored in the procedure file; and
- e. presenting the retrieved access method information.

29. Suzuki discloses a connection file (procedure file) for storing connection data (access method information) for connecting through a control mechanism to a server that stores the requested information (accessing the service based on the access methods in the procedure file) (Suzuki: col. 5, lines 14-20). Suzuki also discloses searching the connection file, therefore the storage location is known (Suzuki: col. 10, lines 36-37). Suzuki further discloses sending a response to the request terminal once a connection has been established (present retrieved access method information to the user) (Suzuki: col. 10, lines 48-49).

30. Ogawa, Skillen and Suzuki are analogous art because they are from the same field of endeavor of information retrieval.

31. At the time of the invention it would have been obvious to a person of ordinary skill in the art to modify the combined system of Ogawa and Skillen by adding a procedure file storing access method information for connection to a service, further including in the ticket, storage location information of the procedure file, the step of retrieving from the ticket obtained by the

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search the corresponding storage location information of the procedure file and retrieving access method information from the procedure file based on the storage location information, acquiring the service provision content information about the service in accordance with an access method stored in the procedure file and presenting the retrieved access method information to the user, as taught by Suzuki.

32. The motivation for doing so would have been because when a user requests data from a server, it may be possible that the type of connection for accessing data on one server may be different from another server. A connection file that contained information on how to connect to each type of server would be advantageous because it would allow connection from a single request terminal using the appropriate connection file instead of multiple request terminals connecting to corresponding servers (Suzuki: col. 1, lines 17-67; col. 2, lines 1-8).

33. In regards to **claim 2**, the limitation was addressed in the rejection to claim 1 above as being disclosed by Skillen. Skillen discloses:

- a. accepting the first identifier and the ticket request submitted by the user, with identification of the user (Skillen: col. 5, lines 61-63; col. 6, lines 4-12); and
- b. storing user information comprising user's preference information and service use information, in correlation with the identification information of the user (Skillen: col. 5, lines 7-17),
- c. wherein the presentation comprises retrieving user information correlated with the identification information of the user acquired in the accepting step, selecting a service provider based on the user information and the service provision content information, and

presenting the service provision content information and access method information about the service provider thus selected (Skillen: col. 6, lines 1-19, 38-43).

34. In regards to **claim 3**, Ogawa discloses wherein the presentation comprises performing a search with a search engine, using a keyword included in the information about the commodity or in the information about the service, as a search key, and presenting link information obtained by the search (Ogawa: para. 0142-1045)<sup>3</sup>.

35. **Claims 4-6** are substantially similar to claims 1-3 in the form of a method and are rejected for the same reasons.

36. **Claim 7** is the substantially similar as claims 1 and 2 combined with additional limitations. In regards to the additional limitations, Ogawa discloses wherein the ticket further comprises permission condition information indicating a condition for the user to whom presentation of the information included in the ticket is permitted (Ogawa: para. 0146)<sup>4</sup>, and wherein the presentation comprises, retrieving user information correlated with identification information of the user acquired in the acceptance step, determining whether the presentation of the information in the ticket to the user is to be permitted, based on the user information and the permission condition information in the ticket, and performing the presentation to the user when the presentation is permitted (Ogawa: para. 0149-0150, 0153-0154).

37. In regards to **claim 8**, Ogawa discloses:

- a. keeping and managing predetermined registration information of members belonging to a community and, in response to the registration request from the member,

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<sup>3</sup> The mail server searches the content database using the relevant information desired by the user (information about the service as a search key) and then forms a return mail to be sent back to the user containing the URLs of the homepage (presents to the user link obtained by the search).

<sup>4</sup> A required password is interpreted as a permission condition.

registering corresponding registration information of the member (Ogawa: para. 0175-0177); and

b. accepting a registration request for registration of a ticket comprising an identifier given to a commodity related to the member information and an access address of the member, which is submitted from the registered member becoming the service provider and desiring to provide information of the access address of the member, and registering the ticket (Ogawa: para. 0176-0181),

c. wherein the storing and managing registers a new ticket comprising the identifier and the access address, based on the registration request for registration of the ticket (Ogawa: para. 0179)<sup>5</sup>.

38. In regards to **claim 9**, Ogawa discloses:

a. keeping and managing predetermined registration information of members belonging to a community and, in response to the registration request from a member, registering corresponding registration information of the member (Ogawa: para. 0175-0177); and

b. accepting an information presentation request for presentation of information of a ticket about a commodity related to the member information from the registered member, and updating the member information stored during the keeping and managing step, to correlate the member information with the permission condition information about the ticket so as to permit the presentation of the information in the ticket to the user (Ogawa: para. 0136-0137, 0146, 0149-0150, 0154).

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<sup>5</sup> The service provider apparatus is interpreted as the ticket storage-management means.

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39. **Claims 10-12** are substantially similar to claims 7-9 in the form of a method and are rejected for the same reasons.

### ***Response to Amendment***

#### **Drawings**

40. Applicant's amendment to the drawings to address duplicate reference characters is acknowledged. Consequently, objection to the drawings is withdrawn.

#### **Specification**

41. Applicant's amendment to the Title, Abstract and Specification to correct minor informalities is acknowledged. The replacement abstract is still too long and is nothing more than a run-on sentence, which is difficult to follow. Applicant is requested to write an abstract that summarizes the claimed invention in a clear manner. Consequently, objection to the specification is maintained.

#### **Rejection of Claims 1-12 under 35 U.S.C 112, Second Paragraph**

42. Applicant's amendment to claims 1-12 is acknowledged. Amendments to the claims corrected the previous problems, however they introduced new ones as explained in the rejection above. The rejection to claims 1-12 under 35 U.S.C. 112, second paragraph is maintained.

#### **Rejection of Claims 1-3 and 7-9 under 35 U.S.C 101**

43. Applicant's amendment to claims 1-3 and 7-9 is acknowledged. However, the amendments do not overcome the rejection as explained above. Consequently, the rejection to claims 1-3 and 7-9 under 35 U.S.C. 101 is maintained.

***Response to Arguments***

**Rejection of claims 1-12 under 35 U.S.C. 103(a)**

44. Applicant's arguments in regards to the rejections to claims 1-12 under 35 U.S.C. 103(a), have been fully considered but they are not persuasive. Applicant alleges that Ogawa (US Patent Pub 2002/0087706) in combination with Skillen et al. (US Patent 6,098,065) hereinafter "Skillen", fails to disclose generating a second identifier from information stored in the first ticket and searching for a second ticket based on the generated second identifier (Page 20 of the Remarks). Applicant further alleges that Skillen uses the same search argument to search a first and second database. The Examiner respectfully disagrees.

45. Skillen discloses using user preferences and previous search arguments to augment search arguments received with the search request (generate second identifier based on acquired information) to select a best fit product advertisement (search for a ticket corresponding to the second identifier) (Skillen: col. 5, lines 9-12). Thus, the combination of Ogawa and Skillen clearly discloses generating a second identifier from information stored in the first ticket and searching for a second ticket based on the generated second identifier.

46. Applicant additionally argues in regards to claim 7, that Ogawa fails to disclose a ticket that comprises 1) permission condition information and 2) a first identifier given to a commodity, an access address of a service provider for providing a service related to the

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commodity, storage location information of the procedure file, and both or one of information about the commodity and information about the service related to the commodity (Page 22 of the Remarks). The Examiner respectfully disagrees.

47. In regards to limitation 1, Ogawa discloses a contents table (interpreted as a plurality of tickets, each row interpreted as a ticket), wherein the contents table comprises “information ID return mails automatically returned to such users who are interested in the corresponding advertisements and transmitted emails” (Ogawa: para. 0125, lines 4-7). Ogawa also discloses after receiving a request from a user, returning to the user a return mail which includes a prepared message extracted from the contents table (Ogawa: para. 0144). Ogawa shows in figure 12, the prepared message as created by the system in response to the user request. As can be seen, the prepared message includes password information (permission condition) (Ogawa: fig. 12, para. 0145). Thus, Ogawa clearly discloses a ticket that comprises a permission condition.

48. Limitation 2 above was addressed in the rejection to claim 1 because it is also a limitation recited in claim 1.

49. Consequently, the rejection to claims 1-12 under 35 U.S.C. 103(a) is maintained.

### ***Conclusion***

50. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

51. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO


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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

52. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Le whose telephone number is 571-272-7970. The examiner can normally be reached on Mon-Thurs : 9:30am-6pm, Fri: 8am-4:30pm.

53. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

54. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
DON WONG  
SUPERVISORY PATENT EXAMINER  
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